REMARKS

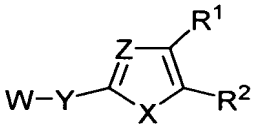
Claims 7, 17, 18, 21-23, 28-33, 36 and 85-89 are pending and under consideration in the instant application.

The specification has been amended on page 1. The amendment to the specification does not add new matter. Entry thereof is respectfully requested.

Claims 7, 17, 18, 21-23, 28-33, 36 and 85-89 stand rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 82-83, 85-91, 96-122 of co-pending U.S. Publication No. 2003/0018022 of U.S. App. No. 10/155,605 ("the '605 application"). Applicants respectfully traverse the rejection.

"Obviousness-type double patenting is a judicially created doctrine intended to prevent *improper* timewise extension of the patent right by prohibiting the issuance of claims in a second patent which are not 'patentably distinct' from the claims of a first patent." *See In re Braat*, 19 U.S.P.Q.2d 1289, 1291-1292 (Fed. Cir. 1991) (emphasis in original). Moreover, the comparison of claims in the instant application are to be made only to what invention is claimed in the earlier patent; the disclosure of a patent cited in support of a double patenting rejection cannot be used as though it were prior art. *See General Foods Corp. v. Studiengesellschaft Kohle mbH*, 23 U.S.P.Q.2d 1839, 1845-1846 (Fed. Cir. 1991)

Independent claim 85 recites a method using a compound of formula **I**, which has the structure:



In formula **I**, W is naphthyl. The allowed claim 82 of the '605 application recites a method using a compound of formula **I** (as pictured above) wherein W is substituted indolyl. As such, the compound genera for use in the claims of the '605 patent do not overlap the genera recited in the instant application. The PTO has not provided any explanation as to why the compounds used in the instant claims would not be patentably distinct from those recited in the '605 application.

Moreover, the PTO issued a Restriction Requirement on November 25, 2005, in the instant application, and a Restriction Requirement on October 3, 2003 in the '605 application. In the elected subject matter for each application, the above-noted differences in W were

among the differences between the compounds for use in the instant application and in the '605 application. In the Office Action dated July 2, 2004, for the '605 application the PTO goes so far as to explain that the "withdrawn subject matter is properly restricted as said subject matters differs in structure and element from the elected subject matter so as to be patentably distinct therefrom, i.e. a reference which anticipated the elected subject matter *would not even render obvious the withdrawn subject matter* and, fields of search are not co-extensive." See page 3 of the '605 application Office Action dated July 2, 2004 (emphasis added). Thus, Applicants respectfully submit, the evidence is that the claims of the instant application are patentably distinct from the subject matter of the claims of the '605 application. Copies of both the Restriction Requirement dated October 3, 2003, and the Office Action dated July 2, 2004, issued by the PTO in the '605 application are enclosed herewith.

In addition, the field of search for the instant application listed by the PTO on the Patent Application Information Retrieval (PAIR) website entry for the instant application is the class/subclass of 548/152, whereas the class/subclass is listed on the PAIR entry as 514/365 for the '605 application. The fact that the fields of search are not co-extensive between the elected subject matter in the instant application and that elected in the '605 application provides further evidence that the claims of the instant application are patentably distinct from claims 82-83, 85-91, 96-122 of the co-pending '605 application.

For the foregoing reasons, Applicants respectfully submit that the rejection of claims 7, 17, 18, 21-23, 28-33, 36 and 85-89 under the judicially created doctrine of obviousness-type double patenting over claims 82-83, 85-91, 96-122 of co-pending U.S. App. No. 10/155,605 is improper and should be withdrawn.

Applicants submit that Claims 7, 17, 18, 21-23, 28-33, 36 and 85-89 satisfy all of the criteria for patentability and are in condition for allowance. An early indication of the same and passage of Claims 7, 17, 18, 21-23, 28-33, 36 and 85-89 to issuance is therefore kindly solicited.

No fee, other than that for an extension of time, is believed to be due with this amendment. If there are any fees or credits due in connection with the filing of this Amendment, authorization is given to charge any necessary fees, or credit any overpayment, to Jones Day Deposit Account No. 50-3013 (referencing 893053-999065).

Respectfully submitted,

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54,398

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